

86366



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application of:) Art Unit: 1614
Applicant: Simone Lemaire, et al.) Confirmation No.: 9394
Serial No.: 10/068,905)
Filed: February 7, 2002)
Title: **HISTOGRANIN-LIKE PEPTIDES AND
NON-PEPTIDES, PROCESSES FOR
THEIR PREPARATION AND USES THEREOF**)
Examiner: Not Yet Assigned)

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop _____, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date.

8/31/04 *Carol T. Shultz*
Date Registration No. 22466
Attorney for Applicant(s)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

In the Office Action of May 26, 2004, the Examiner contends that restriction is required and has defined 12 groups of claims, groups I-XII.

Group I (Claims 1, 2 and 5-11, drawn to a compound of formula I) is provisionally elected with traverse.

The requirement for restriction further provides that if Applicants selects an invention from group A, Applicants are further required to identify which further invention in claim 7 it reads upon, if any (Office Action, page 2).

Applicants submit that provisionally elected group I reads upon compounds I-1 through I-5 in claim 7. The are the cyclic peptides depicted on page 12 of the specification. With respect to the requirement for an election of species (page 6 & 7 of the Office Action) Applicants provisionally elects with traverse: (A) compounds of generic formula I with (3) substitutions of each of R¹-R⁵. To the extent that a single chemical compound must be elected, Applicant provisionally elects with traverse compound I-1 in claim 7.

Applicants' elections are made with traverse.

Applicants submit that the restriction requirement is improper because the claims of groups I-XII are not independent, because they all concern compounds useful for the management of pain.

With respect to the issue of distinctness, the Examiner has not provided an appropriate explanation as to why Groups I-XII are distinct. In order to establish reasons for insisting upon restriction, the Examiner must show by appropriate explanation one of the following:

- A. Separate classification thereof;
- B. A separate status in the art when they are classifiable together; or
- C. A different field of search.

See MPEP § 808.02.

In the instant case, the Examiner acknowledges that all of groups, II-VI and IIX-XII concern subject matter classified in class 530, subclass 300. The Examiner has not established that these groups nevertheless have a separate status in the art or that they required different fields of search. Accordingly, the Examiner has not met the burden of showing by an appropriate explanation that these groups are distinct.

Furthermore, with respect to groups A (compositions of matter) and group B (methods of use of the compositions of matter), Applicants submit that the requirement for restriction is not in compliance with MPEP § 806.05(h), upon which the Examiner relies.

MPEP §806.05(h) requires the Examiner provide an example showing that: (a) the process of using as claimed can be practiced with another materially different product; or (b) the product as claimed can be used in a materially different process. The Examiner has not met this burden.

For this reason, groups A and B should be rejoined, and in particular groups I and VII should be rejoined, and groups II-VI and IIX-XII should be rejoined.

Furthermore: "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." See MPEP § 803.

In the instant case, the majority of the subject matter is acknowledged by the Examiner to be classified in Class 530, Subclass 300, indicating that search and examination of the entire application can be made without serious burden.

For the foregoing reasons, reconsideration and withdrawal of the requirement for restriction are requested.

August 31, 2004

WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
312-655-1500

Respectfully submitted,



Gerald T. Shekleton
Attorney for Applicant
Registration No. 27,466